

Remarks

The April 20, 2006 Official Action has been carefully reviewed. In view of the amendments submitted herewith and the following remarks, favorable reconsideration and allowance of this application are respectfully requested.

At the outset it is noted that a shortened statutory response period of three (3) months was set forth in the April 20, 2006 Official Action. Therefore, the initial due date for response was July 20, 2006. A petition for a one (1) month extension of the response period is presented with this response, which is being filed within the one month extension period.

As a preliminary matter, the Examiner has indicated that newly presented claims 46-49 are drawn to a non-elected invention and has withdrawn the aforementioned claims from consideration.

The Examiner has objected to claims 26 and 32 asserting that they fail to limit the subject matter of the claim from which they depend. The claims have been amended in keeping with the Examiner's helpful suggestion, thereby rendering this objection moot.

At page 4 of the Official Action, the Examiner has rejected claim 27 under 35 U.S.C. 112, second paragraph as allegedly indefinite for reciting a product by process within a method claim.

Claims 1, 4-9, 24, 27-30, 44 and 50 stand rejected for allegedly failing to satisfy the enablement and written description requirements of 35 U.S.C. §112, first paragraph.

Lastly, the Examiner has rejected claims 1, 4-9, 24, and 27-30 under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent 5,977,442.

The foregoing objections and rejections constitute all of the grounds set forth in the April 20, 2006 Official Action for refusing the present application.

In view of the present amendment and the reasons set

forth in this response, Applicants respectfully submit that the objections to the claims; the 35 U.S.C. §112, first paragraph rejections of claims 1, 4-9, 24, 26-30, and 32; the 35 U.S.C. §112, second paragraph rejections of claim 27; and the 35 U.S.C. §102(b) of claims 1, 4-9, 24, and 27-30, as set forth in the April 20, 2006 Official Action, cannot be maintained. These grounds of objection and rejection are, therefore, respectfully traversed.

CLAIM 27, AS AMENDED, MEETS THE REQUIREMENTS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Examiner has rejected claims 27 under 35 U.S.C. §112, second paragraph for alleged indefiniteness. It is the Examiner's position that claim 27 recites a product by process within the method claims and therefore the metes and bounds of the claims are unclear. Applicants respectfully disagree. However, in order expedite prosecution of the present application, Applicants have amended claim 27 to recite a method which further comprises screening additional agents which enhance disease resistance in a plant. It is respectfully submitted that the present amendment serves to remove any perceived ambiguity from the claim. Accordingly, Applicants request that the rejection of claim 27 be withdrawn.

CLAIMS 1, 4-9, 24, 26-30, AND 32, AS AMENDED, SATISFY THE WRITTEN DESCRIPTION AND ENABLEMENT REQUIREMENTS UNDER 35 U.S.C. §112, FIRST PARAGRAPH

The Examiner has rejected claims 1, 4-9, 24, 26-30, and 32 for allegedly failing to satisfy the written description and enablement requirements of 35 U.S.C. §112, first paragraph. It is the Examiner's position that while the specification is enabling for the isolated nucleic acid molecule of SEQ ID NO: 1 and vectors, cells, and plants

comprising the same, the specification allegedly fails to enable an isolated nucleic acid molecule comprising a sequence encoding a polypeptide of SEQ ID NO: 2, a complement of SEQ ID NO: 1, and homologs thereof. The Examiner also contends that the specification describes an insufficient number of species to claim the genus of homologs recited in claim 1.

Applicants continue to disagree with the Examiner's position and submit that specification fully enables and provides an adequate written description of the subject matter originally claimed. However, in the sole interest of expediting prosecution of the instant application, Applicants have amended items a), b), and c) of claim 1 to recite that the isolated SABP2 nucleic acid molecule comprises a sequence selected from the group consisting of SEQ ID NO: 1, a sequence encoding the polypeptide of SEQ ID NO: 2, and a homolog of SABP2 encoded by SEQ ID NO: 36. Inasmuch as each of these sequences is disclosed in the application, Applicants submit that the specification is fully enabling and provides an adequate written description for the nucleic acid molecules recited in amended claim 1. Indeed, the MPEP at 2163(II)(A)(3)(a)(ii) states that upon the disclosure of an amino acid sequence, "it would be unnecessary to provide an explicit disclosure of nucleic acid sequences that encoded the amino acid sequence" because the skilled artisan is well-apprieved of the genetic code.

It is also submitted that the foregoing amendment to claim 1 removes any grounds for rejecting the claims under the written description prong of 35 U.S.C. §112, first paragraph as each of the recited sequences are provided in the application.

In view of the foregoing, Applicants submit that the Examiner's rejections of claims 1, 4-9, 24, 26-30, 44 and 50 for allegedly failing to satisfy the written description and enablement requirements of 35 U.S.C. §112, first paragraph are untenable and respectfully request their withdrawal.

**CLAIMS 1, 4-9, 24, AND 27-30, AS AMENDED, ARE NOT ANTICIPATED
BY U.S. PATENT 5,977,442**

The Examiner has rejected claims 1, 4-9, 24, and 27-30 under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent 5,977,442.

For the reasons stated hereinabove, Applicants have amended claim 1, from which claims 4-9, 24, and 27-30 depend, to recite that the SABP2 nucleic acid molecule comprises a sequence selected from the group consisting of SEQ ID NO: 1, a sequence encoding the polypeptide of SEQ ID NO: 2, and a homolog of SEQ ID NO: 1 having the sequence of SEQ ID NO: 36.

Applicants respectfully submit that the '442 patent fails to teach the nucleic acid encompassed by claim 1 as amended. Indeed, the protein disclosed in the '442 patent is a MAP kinase which does not bind salicylic acid, whereas the instantly claimed SABP2 binds salicylic acid and has esterase/lipase activity.

Inasmuch as the '442 patent fails to teach each and every element of claim 1 and dependent claims 4-9, 24, and 27-30, Applicants submit that the instant rejection under 35 U.S.C. §102(b) is untenable and respectfully request its withdrawal.

CONCLUSION

It is respectfully requested that the amendments presented herewith be entered in this application, since the amendments are primarily formal, rather than substantive in nature. This amendment is believed to clearly place the pending claims in condition for allowance. In any event, the claims as presently amended are believed to eliminate certain issues and better define other issues which would be raised on appeal, should an appeal be necessary in this case.

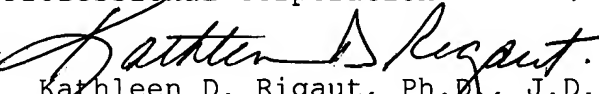
In view of the present claim amendments, and the

foregoing remarks, it is respectfully urged that the rejections set forth in the April 20, 2006 Official Action be withdrawn and that this application be passed to issue. In the event the Examiner is not persuaded as to the allowability of any claim, and it appears that any outstanding issues may be resolved through a telephone interview, the Examiner is requested to telephone the undersigned attorney at the phone number given below.

Respectfully submitted,

DANN, DORFMAN, HERRELL AND SKILLMAN
A Professional Corporation

By


Kathleen D. Rigaut, Ph.D., J.D.
PTO Registration No. 43,047

Telephone: (215) 563-4100